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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,559	06/18/2001	Michael Kramer	113.1010	3025

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EXAMINER	
ANGELL, JON E	
ART UNIT	**PAPER NUMBER**
1633	8

DATE MAILED: 11/23/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/787,559	KRAMER ET AL.	
	Examiner	Art Unit	
	Dave Nguyen	1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claims 1-28 are pending in the application.

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1, 7, 25, and 26 drawn to a polypeptide and a reagent containing a polypeptide (choose either SEQ ID No.2 or SEQ ID No. 3).

Group II, claim(s) 2-6, 8-11, 17, 18, 20 and 24, drawn to a nucleic acid, vector containing the nucleic acid, a cell transformed with the nucleic acid, a reagent containing a nucleic acid, and a diagnostic method using a nucleic acid (choose either SEQ ID No. 1 or SEQ ID No. 4).

Group III, claim(s) 5, 18, and 20, drawn to antisense nucleic acids and a diagnostic method using antisense nucleic acids (choose either SEQ ID No. 1 or SEQ ID No. 4).

Group IV, claim(s) 12 and 21, drawn to "use" of a nucleic acid for manufacturing transgenic mammals (choose either SEQ ID No. 1 or SEQ ID No. 4).

Group V, claim(s) 13, 15, 22 and 23, drawn to "use" of a polypeptide for manufacturing an antibody (choose either specific for SEQ ID No. 2 or SEQ ID No. 3) and the antibody.

Group VI, claim(s) 14 and 16, drawn to a diagnostic method using an antibody (choose either specific for SEQ ID No. 2 or SEQ ID No. 3).

Group VII, claim(s) 14 and 16, drawn to method of treatment using an antibody (choose either specific for SEQ ID No. 2 or SEQ ID No. 3).

Group VIII, claim(s) 18, drawn to "use" of a nucleic acid in a method of treatment (choose either SEQ ID No. 1 or SEQ ID No. 4).

Group IX, claim(s) 18, drawn to "use" of an antisense nucleic acid in a method of treatment (choose either SEQ ID No. 1 or SEQ ID No. 4).

Group X, claim(s) 19 and 27, drawn to "use" of a polypeptide to identify modifiers of polypeptide function or expression (choose either SEQ ID No. 2 or SEQ ID No. 3).

Group XI, claim(s) 28, drawn to "use" of a nucleic acid to identify modifiers of polypeptide function or expression (choose either SEQ ID No. 1 or SEQ ID No. 4).

NOTE: the polypeptide and antibody claims (for example claims 1, 7, 13, 15, 22, and 23) are drawn to a polypeptide having a sequence of either SEQ ID No. 2 or SEQ ID No. 3 and an antibody specific for such a polypeptide. These claims encompass two different polypeptides, each having a unique amino acid sequence. Therefore, each polypeptide and antibody is a unique invention. Applicant is required to elect one invention (i.e. one SEQ ID No. or an antibody specific for one polypeptide) for examination. For example, Applicant must choose Group I as directed towards SEQ ID No. 2, or Group I as directed towards SEQ ID No. 3. Similarly, the nucleic acid claims including the antisense nucleic acid claims and the transgenic mammal produced using the nucleic acids (for example claims 2-6, 8-12, 20 and 21) are drawn to a nucleic acid having a sequence of either SEQ ID No. 1 or SEQ ID No. 4. These claims encompass two different polynucleotides, each having a unique sequence. Therefore, each polynucleotide is considered a unique invention. Applicant is required to elect one invention (i.e. one SEQ ID No.) for examination. Furthermore, claims 5, 14, 16, and 18 contain multiple inventions which do not relate to a single inventive concept under PCT rule 13.2. Therefore, claims 5, 14, 16, and 18 appear in multiple groups where each group contains a different invention of the claim.

The inventions listed as Groups I-XIV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Groups I, V-VII, XIII and XIV are directed to proteins; Groups II, III, IX-XII, and XV are directed to nucleic acids; Group IV is directed to a transgenic mammal. These general categories of Groups lack the same or corresponding special technical feature because proteins, nucleic acids, and transgenic mammals represent materially different compositions with different functions. Rule 37 CFR 1.47 (b) and (d) does not provide for separate products.

Although Groups I, V-VII, XIII and XIV are directed to proteins, they lack the same or corresponding special technical feature because Groups I, XIII and XIV are directed to polypeptides while Groups V-VIII are directed to antibodies. The polypeptides and antibodies have different chemical structures and different functions. Furthermore, there exists more than one distinct polypeptide having the claimed function (e.g. SEQ ID No.2 and SEQ ID No. 3); therefore there is more than one polypeptide that can be "used" in the inventions of Group XIII ("use" of a polypeptide to identify modifiers) and Group XIV (a reagent containing a polypeptide for detecting a protein).

Groups V-VII are all directed to antibodies, however a special technical feature does not exists between Groups V-VII because each of these Groups involves diverse and separate areas of consideration. Group V is drawn to an antibody, Group VI is drawn to a diagnostic method using an antibody and Group VII is drawn to a method of treatment using an antibody.

Although Groups II, III, IX-XII and XV are directed to nucleic acids, they lack the same or corresponding special technical feature because Groups II, IX, X, and XV are drawn to nucleic acids and Groups III, XI, and XII are directed to "anti-sense" nucleic acids. The nucleic acids and "anti-sense" nucleic acids have different chemical structures and different functions. Furthermore, there exists more than one nucleic acid having the claimed function (e.g. SEQ ID No. 1 and SEQ ID No. 4); therefore, there is more than one nucleic acid and "antisense" nucleic acid that can be "used" in the inventions of Group II, III, IX-XII, and XV. Groups IX-XII and XV are directed to different methods involving nucleic acids and "antisense" nucleic acids. Each of the methods involves diverse and separate areas of consideration.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Eric Angell whose telephone number is (703) 605-1165. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Clark can be reached on (703) 305-4051. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

J. Eric Angell
November 19, 2001

Deborah Clark
DEBORAH J. R. CLARK
SUPERVISORY PATENT EXAMINER
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